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09/891,474

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Dale F. McIntyre

83010F-P

9394

Milton S. Sales
Patent Legal Staff
Eastman Kodak Company
343 State Street
Rochester, NY 14650-2201

7590

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EXAMINER

JOO, JOSHUA

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|--|--|
| Office Action Summary | Application No. 09/891,474 | Applicant(s) MCINTYRE ET AL. | |
| | Examiner JOSHUA JOO | Art Unit 2454 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 October 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 September 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Detailed Action

This Office action is in response to Applicant's communication filed on 10/23/2009.

Claims 1-15 are pending for examination.

Response to Arguments

Applicant's arguments with respect to claims 1-15 have been considered but are moot in view of the new ground(s) of rejection. New ground(s) of rejection are necessitated by Applicant's amendment.

Claim Objections

Claims 5, 13-15 are objected to because of the following informalities:

- a) Regarding claim 5, "said electric camera" should be changed to "said electronic camera" to clearly refer "an electronic camera" of claim 3.
- b) Regarding claims 13-15, the claims recite "said instructions". However, claim 12, which claims 13-15 depend on, recite "instruction". Thus, "said instructions" should be changed to "said instruction" or "instruction" to "instructions".

Appropriate correction is required.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-10 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Regarding claim 1, Applicant is seeking to patent a system comprising a device. The claimed system and the device do not comprise any functional hardware. Given the broadest reasonable interpretation, a device may be interpreted as software. For instance, The Authoritative Dictionary of

IEEE Standards Terms, Published December 2000, defines “device” as “(software) A mechanism or piece of equipment designed to service a purpose or perform a function”. The claimed system is considered as a software system and software does not meet one of the four categories of invention and is not statutory.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 4, 12-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- a) Regarding claim 4, “said user computer” has insufficient antecedent basis.
- b) Regarding claim 12, it is unclear if “said information” is referring to “information unique to said user” or “information for allowing controlled access”.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1 and 4 are rejected under 35 U.S.C. 102(e) as being anticipated by Knowlton et al. US Patent #6,057,842 (Knowlton hereinafter).

As per claim 1, Knowlton teaches the invention as claimed including a system for managing digital images, comprising:

a device for creating an image media file including an electronic icon and information unique to a particular user including information allowing access with respect to a particular digital media file having said icon associated therewith over a communication network by a third party (col. 11, line 47-52; col. 13, lines 55-67. Generate visual link which will include icon, text, title. col. 14, lines 1-4, 25-30, 42-45. Visual link contains graphic icon. col. 4, lines 6-14; col. 10, line 30-35; col. 54, line 19-25. Provide a user with access to document, file, etc... figs. 5C; 5G. col. 58, lines 35-50. File contains icon and visual link data 500.); and

the system including means for utilizing said information for providing said access by said third party (col. 4, lines 6-14; col. 54, lines 6-25, 64-67; col. 55, lines 1-2. Provide a user with access to document, file, etc.).

As per claim 4, Knowlton teaches the system according to claim 1 further comprising a communication device for transferring said digital media file from said user computer over said communication network (col. 4, lines 6-14; col. 54, line 6-25. Provide a user with access to document, file, location).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 9, 11-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Knowlton, in view of Angiulo et al. US Patent #6,275,829 (Angiulo hereinafter).

As per claim 11, Knowlton teaches substantially the invention as claimed including a method for managing digital images by a service provider on a computer of a user over a communication network, comprising:

creating an image media file including an electronic icon and information unique to said user that includes information for allowing controlled access by a designated third party to a particular digital media file stored on said computer (col. 11, line 47-52; col. 13, lines 55-67. Generate visual link which will include icon, text, title. col. 14, lines 1-4, 25-30, 42-45. Visual link contains graphic icon. col. 4, lines 6-14; col. 10, line 30-35; col. 54, line 19-25. Provide a user with access to document, file, etc... stored on web servers. figs. 5C; 5G. col. 58, lines 35-50. File contains icon and visual link data 500.);

accessing said computer over said communication network and locating digital media files having said icon associated therewith and allowing access to said digital media files by said designated third party (col. 4, lines 6-14; col. 54, lines 6-25, 64-67; col. 55, lines 1-2. Provide a user with access to document, file, etc...).

Knowlton does not specifically teach of a service provider accessing said computer.

Angiulo teaches of a service provider accessing a digital media file from a computer (col. 9, lines 20-27, 30-35).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings for a service provider to access the computer. The motivation for the suggested combination is that Angiulo's teachings would improve Knowlton's teachings by enabling a user to receive media file by utilizing a server to obtain the media file at different locations.

As per claim 2, Knowlton teaches the system according to claim 1 wherein said device for creating said electronic icon comprises a user computer. Knowlton does not specifically teach said digital media file is stored in a memory device in said user computer.

Angiulo teaches of using a computer to create an icon and storing a digital media file in a memory of the computer (col. 7, lines 45-57; col. 9, lines 10-26; col. 9, lines 20-22).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings to create an icon and store digital media file in a memory of the computer. The motivation for the suggested combination is that Angiulo's teachings would improve Knowlton's teachings by enabling efficient sharing of content such that amount of data transferred is reduced.

As per claim 9, Knowlton teaches the system according to claim 2 wherein a service provider having access to said digital media file so as to obtain said icon. Angiulo does not specifically teach allow access in accordance with said information.

Angiulo teaches of a service provider accessing a digital media file from a computer (col. 9, lines 20-27, 30-35).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings for a server provider to access a digital media file from a computer. The motivation for the suggested combination is that Angiulo's teachings would improve Knowlton's teachings by enabling a user to receive media file by utilizing a server to obtain the media file at different locations.

As per claim 12, Knowlton teaches the method according to claim 11 wherein said information comprises instruction with respect to said digital image files (col. 54, lines 51-62, col. 55, lines 1-16. Information such designating location for accessing document.).

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As per claim 13, Knowlton teaches the method according to claim 12 wherein said instructions comprises forwarding said digital media file to said designated third party (col. 4, lines 6-14; col. 54, lines 6-25, 64-67; col. 55, lines 1-2. Provide access to document, file, etc).

As per claim 14, Knowlton teaches the method according to claim 13 wherein said instructions comprises forwarding an electronic address of said digital media file to said designated third party such that said designated third party may directly access said digital media file (col. 54, lines 51-62, col. 55, lines 1-16. Designate location for accessing document.).

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Knowlton, in view of Tomat et al, US Patent #6,784,925 (Tomat hereinafter).

As per claim 3, Knowlton does not specifically teach the system according to claim 1 wherein an electronic camera is used to create said electronic icon and automatically associates said electronic icon with digital media files captured by said electronic camera.

Tomat teaches of an electronic camera used to create thumbnails, e.g. icons, (col. 6, lines 9-19) and associates thumbnails with the full image files (col. 8, lines 1-12).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings to use a camera to create the electronic icon and automatically associate the thumbnails with digital media files. The motivation for the suggested combination is that Tomat's would improve Knowlton's teachings by allowing efficient generation of electronic icons for a user.

Claims 5-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Knowlton and Tomat, in view of Anderson, US Patent #7,287,088 (Anderson hereinafter).

As per claim 5, Knowlton teaches the system according to claim 3 wherein said electronic icon includes instructions for further processing of said digital image file (col. 54, lines 51-62; col. 55, lines 35-45). Knowlton does not specifically teach wherein said electronic camera has a communication device for transferring said digital media file to a service provider

Anderson teaches of an electronic camera having a communication device for transferring said digital media file to a service provider (col. 3, lines 23-30, 44-48).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings for the electronic camera to have a communication device for transferring said digital media file to a service provider. The motivation for the suggested combination is that Anderson's teachings would improve the suggested system by reducing storage and transmission bandwidth requirements.

As per claim 6, Knowlton does not teach the system according to claim 5 wherein said provider provides confirmation of receipt of said digital media file to said electronic camera.

Anderson teaches of providing a confirmation of receipt of a digital media to an electronic camera (col. 6, lines 4-9).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings to provide a confirmation of receipt of the files. The motivation for the suggested combination is that Anderson's teachings would improve the user friendliness of the suggested system by providing an indication of successful transmission of files and reducing storage and transmission bandwidth requirements.

Claims 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Knowlton, Tomat, and Anderson, in view of Stumer, US Publication #2002/0035630 (Stumer hereinafter).

As per claim 7, Knowlton does not specifically teach the system according to claim 6, wherein said confirmation further includes confirmation of said instructions.

Stumer teaches of providing confirmation of received instructions (Paragraphs 0025-0026).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings for the confirmation to include confirmation of instructions. The motivation for the suggested combination is that Stumer's teaching would improve the suggested system by providing status of transmitted data thus enabling a sender to resend data if a confirmation is not received.

As per claim 8, Knowlton does not specifically teach the system according to claim 5 wherein said instructions includes the automatically forwarding of said digital media file to a third party.

Stumer teaches of instructions to automatically forwarding data to a third party (Paragraphs 0022, 0027).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings to send instructions that include the automatically forwarding of digital media file to a third party. The motivation for the suggested combination is that Stumer's teaching would improve the suggested system by enabling efficient transfer of data.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Knowlton, Tomat, and Anderson, in view of Uchiyama, US Patent #6,731,341 (Uchiyama hereinafter).

As per claim 10, Knowlton does not teach the system according to claim 5 wherein said communication device is a wireless phone.

Uchiyama teaches that an electronic camera attached to a wireless phone (col. 12, lines 39-51).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings to have an electronic camera attached to a wireless phone. The motivation for the suggested combination is that Uchiyama's teachings would improve the suggested system by allowing wireless transmission of images that have photographed with the camera.

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Knowlton and Angiulo, in view of Anderson.

As per claim 15, Knowlton does not specifically teach the method according to claim 14 wherein said digital media file is a low resolution copy of a higher resolution media file.

Anderson teaches of concept of generating a low resolution copy of a higher resolution media file (col. 7, lines 1-4, 9-14; claim 4).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings for the digital media file to be a low resolution copy of a higher resolution media file. The motivation for the suggested combination is that Anderson's teachings would improve the suggested system by reducing storage and transmission bandwidth requirements.

Conclusion

A shortened statutory period for reply to this Office action is set to expire THREE MONTHS from the mailing date of this action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joshua Joo whose telephone number is 571 272-3966. The examiner can normally be reached on Monday to Friday 8AM to 5PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan J. Flynn can be reached on 571 272-1915. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/J. J./

Examiner, Art Unit 2454

/NATHAN FLYNN/

Supervisory Patent Examiner, Art Unit 2454